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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,794	07/18/2000	James Norman Cawse	RD-26357	8865

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EXAMINER

FRIEND, TOMAS H F

ART UNIT

PAPER NUMBER

1627

DATE MAILED: 07/16/2002 16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/618,794

Applicant(s)

CAWSE, JAMES NORMAN

Examiner

Tomas Friend

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 26 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26 and 29-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **Detailed Action**

### **Status of the Application**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 April 2002 has been entered.

### **Status of the Claims**

Claims 1-15, 26, and 29-35 are pending in the present application. Claims 1-15 were withdrawn from further consideration as being drawn to non-elected inventions in Paper No. 7. Claims 26 and 27 were cancelled as per applicant's request in Paper No 12. Claims 26 and 29-35 are pending and examined on their merits.

### **Objections to the Claims**

1. Claim 31 remains objected to because it appears to be missing the word "*to*" in line 1 between "*proximate*" and "*said.*"

### **Withdrawn Rejections/Objections**

2. The rejection of claims 26 and 27 under 35 U.S.C. 102(b) as being anticipated by Cody et al. (1994) U.S. Patent No. 5,324,483 are withdrawn in response to applicant's cancellation of the claims.

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3. The rejection of claims 26-35 under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements is withdrawn in response to applicant's amendment.

### **New Grounds of Rejection**

#### **New Grounds of Rejection – 35 U.S.C. 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26 and 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Styllki et al. U.S. Patent No. 5,985,214 November 1999 and Bagshawe et al. U.S. Patent No. 3,784,826 January 1974.

The Styllki et al. patent teaches systems and methods for automated workstations for identifying chemicals (abstract). The workstation includes a reaction module that provides reagents for chemical reactions (column 6, lines 36-39). Column 36, lines 5-9 and 47-67, teaches that the workstation may include an incubator (vessel) in which reactions are incubated that provides a controlled atmosphere with respect to CO<sub>2</sub> or O<sub>2</sub> levels, humidity, and/or temperature, for example. The incubator has ingress and egress points which allow automated access. The incubator and reaction module are operably linked by a conveyer system that moves racks of samples (column 2, lines 56-64; column 4, lines 42-45; and figures 3, 11, and 12B). All elements of the workstation are integrated through a data processing and integration module (column 3, lines 8-18).

The Styllki et al. patent does not explicitly teach chemical combinatorial synthesis or the presence of airlocks at separate ingress and egress points of the incubator (vessel).

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The Bagshawe et al. patent teaches an apparatus for carrying out assays in a continuous fashion (abstract and column 1, lines 5-13). The apparatus includes an incubator with separate ingress and egress points as well as a transport system for arrays of analytical samples.

It would have been obvious to one of ordinary skill at the time that the invention was made to use the system of Styllki et al. for chemical combinatorial synthesis using the continuous method of Bagshawe et al. (which requires separate ingress and egress points for samples in the incubator). One would have been motivated to do so because both systems inherently involve the addition of reagents to samples containing different compositions and the reaction of reagents with those samples to produce products. One would have had a reasonable expectation for success because the cited systems were in use and chemical reactions performed for analytical purposes are not fundamentally different from other chemical synthetic reactions. One of ordinary skill would have understood that such a system would inherently have been able to perform chemical synthesis reactions as well as analytical reactions.

One of ordinary skill would have been motivated to combine the two systems because the Bagshawe et al. apparatus allows for the reaction of samples on a continuous basis to speed up procedures and reduce cost (see column 1, lines 6-9, of Bagshawe et al.). One would have had a reasonable expectation for success because the continuous method of analysis is encompassed by the Styllki et al. system.

With respect to the presence of airlocks at the ingress and egress points of the incubation chamber, it would have been obvious to one of ordinary skill at the time that the invention was made to employ airlocks at the ingress and egress points to the incubator in circumstances where atmospheric control required atmospheric conditions such as high or low pressure, high or low temperature, or atmospheric gasses that are toxic or reactive with components of the normal atmosphere.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tomas Friend** at telephone number **(703) 308-4548**. The examiner can normally be reached on Monday, Tuesday, Friday, and Saturday 8:00-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (703) 308-4537. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2742.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1235.

Tomas Friend, Ph.D.  
15 July 2002

  
**PADMASHRI PONNALURI**  
**PRIMARY EXAMINER**